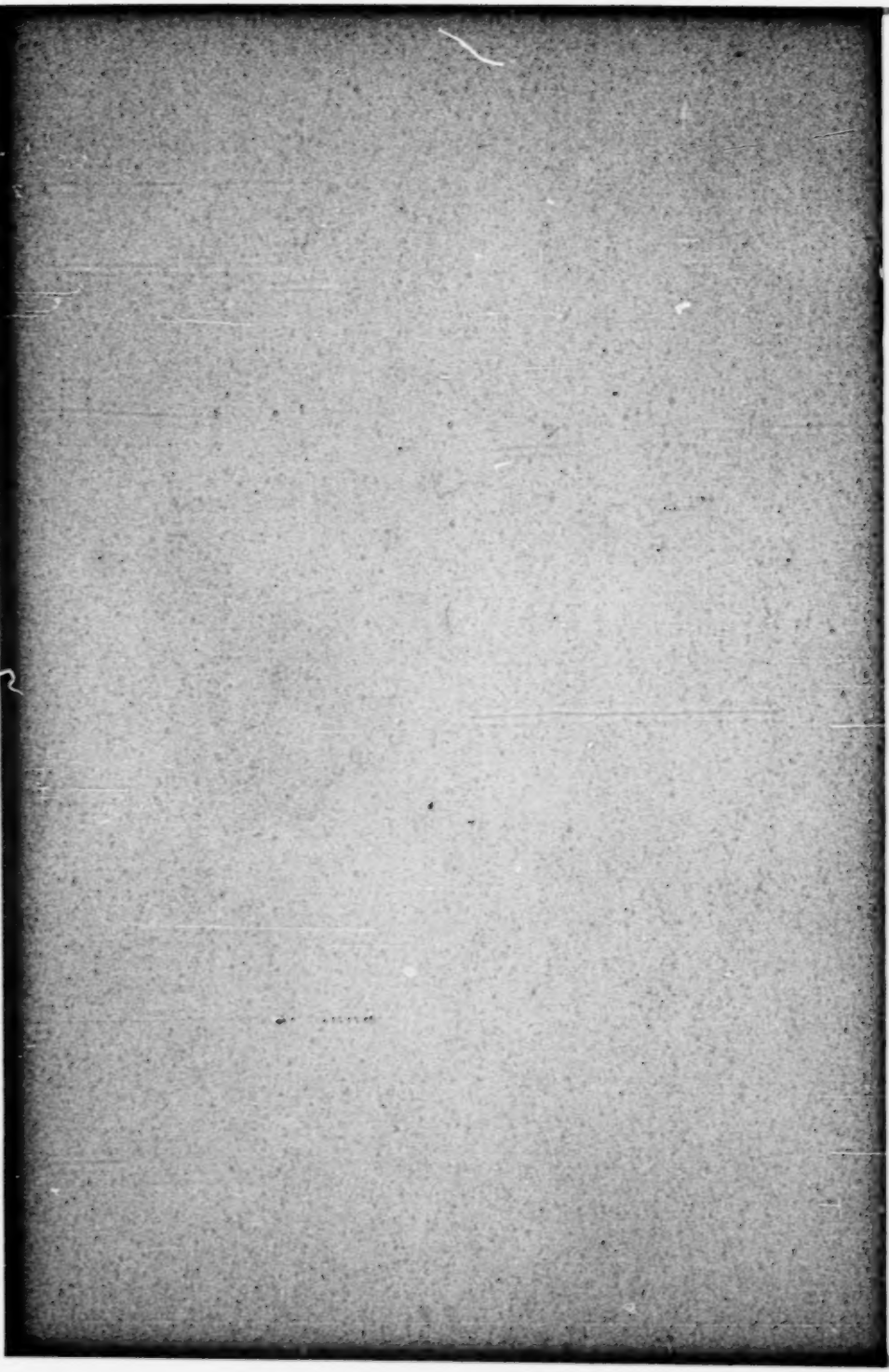

SUPREME COURT, U. S.

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MICHAEL RODAK, JR.

IN THE

Supreme Court of the United States

OCTOBER TERM, A.D. 1973

No. 73-1677

BORG-WARNER CORPORATION,

Petitioner,

vs.

KING-SEELEY THERMOS CO.,

Respondent.

PETITIONER'S REPLY BRIEF

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Respondent does not meet the question of whether its patent discloses the crucial feature of the invention. Rather, the Respondent seeks to divert the Court's attention away from the critical issue by the assertion that this is the "last" of the infringement suits on this patent, and that it has expired. Respondent fails to mention that infringement suits can still be brought on this patent for a period of up to six years after it expires.

Respondent argues that Petitioner did not, in the courts below, raise the critical issue presented here. Such is not the case. In its own Brief (on page 6), Respondent admits "In the lower courts Borg-Warner contended that in the '694 patent machine compressing of the rising column of slush ice by the ice disintegrating and removing member not only did not occur but was not mentioned in the patent".

Respondent's argument that there is no conflict between circuits is also incorrect. The Brief presented by Respondent does not mention the *Ardac* case, to which reference is made on page 8 of the Petition here. Furthermore, the Second Circuit *Carter-Wallace* case is directly contrary to the holding below here.

As in this case, earlier decisions on the patent in the *Carter-Wallace* case had all found the patent valid. However, when the deficient specification was called to the attention of the Second Circuit, it found the patent invalid. In doing so it stated:

> "The disclosure of a patent should, upon issuance, immediately add a patentable invention to the existing fund of knowledge in the field; it must do more than merely suggest experimentation which would lead to the discovery of the patentable property".

That decision also quoted Judge Learned Hand:

> "Even though it were possible that a person skilled in the art might see it was not absolute length, but the ratio of length to cross-section that was important, we should not be justified in validating such an expansion of the original; it is the sort of artful extrapolation against which courts have over and over set their faces. * * * A patent must be a certain guide; not a congeries of pregnant suggestions".

In contradistinction, the Seventh Circuit in this case found the patent valid even though it realized fully and explicitly stated ". . . neither the specification nor claims in the '694 patent contain any reference to making ice chips by compaction and extrusion".

Thus, that which the courts below found to be omitted was the very essence of Respondent's patent. In fact, the courts below specifically found that the *only* difference between the claim in suit and the prior art was the undisclosed, crucial function "that a column of soft or slushy ice is compressed, dewatered, broken up or fractured, and discharged from the cylinder as commercially acceptable discrete ice chips or particles. . . ." (Finding 15). The courts below also concluded that this sole difference between the patent and the prior art was not disclosed in the patent. Rather, they justified the omission through the doctrine of inherency.

The recent decision of this Court in *Kewanee Oil Co. v. Bicron Corp. et al*, ... U.S. ....., holds:

> "The stated objective of the Constitution in granting the power to Congress to legislate in the area of intellectual property is to 'promote the Progress of Science and useful Arts.' . . . In return for the right of exclusion . . . the patent laws impose upon the inventor a requirement of disclosure. To insure adequate and full disclosure so that upon the expiration of the 17-year period 'the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use' . . . the patent laws require that the patent application shall include a full and clear description of the invention and 'of the manner and process of making and using it' so that any person skilled in the art may make and use the invention. 35 U.S.C. 112.

> When a patent is granted and the information contained in it is circulated to the general public and those especially skilled in the trade, such additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of 17 years of exclusive use for its disclosure . . ."

If the foregoing conclusion by this Court is to be a vital part of the law in action, as distinguished from part of the library of dead legal lore, it is respectfully submitted that this Court must, in this case, construe 35 U.S.C. 112. There has been no decision on the requirements for patent disclosure since the Patent Laws were revised in 1952. Petitioner therefore prays that the Writ issue.

Respectfully submitted,

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